



UNITED STATES PATENT AND TRADEMARK OFFICE

MC
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,712	01/21/2004	Harrison F. Dillon	H2042101-CIP	6531
46148	7590	02/21/2006		
SOLAZYME, INC. 3475 - T Edison Way Menlo Park, CA 94025			EXAMINER SCHLAPKOHL, WALTER	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,712

Applicant(s)

DILLON, HARRISON F.

Examiner

Walter Schlapkohl

Art Unit

1636

WLF

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1636

DETAILED ACTION

Examiner has found that the requirement for election/restriction sent 11/3/2005 was in error and has regrouped the inventions presented in the original claim set of 1/21/2004. Examiner apologizes for this misunderstanding and would like to offer Applicant the option of phoning in the response to the new requirement for election/restriction in order to expedite prosecution.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups 1-112. Claims 2-28, drawn to a method for engineering a cell to produce an increased amount of hydrogen comprising screening a cell with a mutagenized nucleic acid for increased hydrogen, wherein the mutagenized nucleic acid is selected from a gene from claim 3 and/or a (corresponding) gene sequence selected from SEQ ID NOs: 1-112, classified in class 435, subclass 471.

Group 113. Claims 29-30, drawn to a method of hydrogen production, classified in class 435, subclass 41.

Art Unit: 1636

Group 114. Claims 31-38, drawn to a method of multiparent mating of microbes that mate in response to a stimulus, classified in class 435, subclass 471.

NOTE: There are two claims numbered 36. Both are included in Group 114. Appropriate correction of the claim numbering is required.

Claim 1 link(s) inventions 1-112. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Art Unit: 1636

Applicant(s) are advised that if any claim(s) including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Groups 1-112 are comprised of multiple independent and/or distinct inventions recited in the alternative which are the products or methods drawn to different genes which do not render obvious each other and thus are patentably distinct. Applicant must elect a single invention which is the product or method drawn to one specific gene to which the claims will be restricted. Applicant must also indicate which claims are readable on the elected invention. This is not an election of species because the genes are different and distinct and thus

Art Unit: 1636

the methods drawn to different and distinct genes are different and distinct inventions from each other. Note, this restriction to examination of a single sequence is due to the now very high and undue burden for examining more than one sequence which is caused by the continued exponential increase in size of the sequence databases to be searched for each sequence, resulting in a corresponding increase in computer search time and examiner time for reviewing the computer search results. Therefore, the limited resources of the Office no longer permit examination of more than one sequence in an application.

Note: the non-standard format of this restriction, separating the inventions into multi-invention groups drawn to independent or distinct types of products and methods, followed by an election of a single invention drawn to one sequence within the elected multi-invention group, was done for the sake of compactness of the communication and clarity, instead of using the more standard format setting forth each separate invention drawn to each separate sequence which would require a much longer communication.

The inventions of Groups 1-112, 113 and 114 are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The

Art Unit: 1636

methods of Groups 1-112, 113 and 114 comprise steps which are not required for or present in the methods of the other groups: transforming a cell with a mutagenized nucleic acid sequence (Groups 1-112), collecting an evolved gas (Group 113) and multiparent mating of microbes that mate in response to a stimulus (Group 114).

Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper. Furthermore, each product requires a separate search of the patent and non-patent literature. The searches are not co-extensive, and the additional searching that is required to search more than one group would impose a serious search burden.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

Art Unit: 1636

be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Certain papers related to this application may be submitted to the Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is (571) 273-8300. Note: If Applicant does submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the

Art Unit: 1636

problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent applications to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at (800) 786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Walter A. Schlapkohl whose telephone number is (571) 272-4439. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office.)

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.


NANCY VOGEL, PH.D.
PATENT EXAMINER

Walter A. Schlapkohl, Ph.D.
Patent Examiner
Art Unit 1636

February 12, 2005